

# Notice of Allowability

Application No.

10/009,407

Examiner

Robert Shiao

Applicant(s)

CORBIER ET AL.

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## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on July 07, 2005.
2. ☒ The allowed claim(s) is/are 1-16 and 20-23, now are 1-20.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_



### **DETAILED ACTION**

1. This application claims priority of the foreign application: FRANCE 99/07252 with a filing date 06/09/1999. A certified copy of the English-translated version of the foreign priority document has been filed. Therefore, the foreign priority is granted.
2. Amendment of claim 1, cancellation of claims 17-19, and a terminal disclaimer in the amendment filed on 07/07, 2005, is acknowledged. Claims 1-16, and 20-23 are pending in the application.

### ***Responses to Amendment***

3. Since limitation "all possible isomeric forms" has not been incorporated into claim 1, therefore, rejection of claims 1-16, and 20-23 under 35 U.S.C. 112, first paragraph, is maintained. Rejection of claims 1-16 and 20-23 under 35 U.S.C. 112, second paragraph, has been overcome in the amendment filed on 07/07, 2005.
4. Since the foreign priority has been granted, therefore, the document WO 99/29716 or US 6,677,429 is not qualified as prior art. Rejection of claims 1-16 and 20-23 under 35 U.S.C. 102(a) or 103(a), has been withdrawn herein.
5. Since a terminal disclaimer has been filed and approved, therefore, rejection of claims 1-16 and 20-23 under obviousness-type double patenting over Courtin et al. US 6,677,429, has been overcome in the amendment filed on 07/07, 2005. Since the provisional obviousness-type double patenting over co-pending Application No. 10/666,072, is the only remaining rejection, therefore,

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the provisional rejection of claims 1-16 and 20-23 under obviousness-type double patenting, is withdrawn herein.

### **EXAMINER'S AMENDMENT**

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Charles A. Muserlian on September 15, 2005. The application has been amended as follows:

In claim 1, line 2, after "possible", delete "isomeric", and insert  
--stereoisomeric--



In claim 1, page 3, line 1, after "a double bond", delete "a double bond"

In claim 1, page 3, lines 8-9, delete "and heterocycle containing at least one heteroatom"

***Reasons for Allowance***

7. The following is an examiner's statement of reasons for allowance:

Claim 1-16 and 20-23 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to Novel echinocandin derivatives, method for preparing same and use as antifungal agents. The closest reference is Giacobbe et al. US 4,968,608, discloses process for antifungal fermentation product. The difference between Giacobbe et al. and instant claims is that the instant compounds of formula (I) are not found in Giacobbe et al. Suggestion for modification of above record to obtain the instant claimed compounds/compositions, processes of making, and methods of use, has not been found. Claims 1-16 and 20-23 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707.

The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number


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for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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September 19, 2005